

## **Remarks**

### **1) Claims 69 and 70: McAlpine Does Not Constitute Prior Art under 102(e)/103(c)**

Claims 69 and 70 stand rejected under 35 U.S.C. 103(a) based, in part, on McAlpine (U.S. 2002/0141427). Given the filing and publication dates stated on McAlpine, the Examiner presumably is asserting that McAlpine constitutes prior art to the subject application solely under the provisions of 35 USC §102(e). However, the subject application and McAlpine were, at the time that the invention of the subject application was made, owned by the Assignee of the subject application, Intel Corporation. The assignment for McAlpine to Intel Corporation is recorded on reel/frame 011649/0663 on 3/30/2001. Accordingly, under the provisions of 35 USC §103(c) and MPEP §706.02(I)(1), McAlpine does not constitute prior art that can be used to reject the subject application in the above obviousness rejections.<sup>1</sup> As such, Attorney for Applicant requests withdrawal of the rejections of claims 69 and 70 based on McAlpine.

### **2) The Combination of Williams and Lee is Improper Under MPEP 2145**

#### **X.D.2**

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<sup>1</sup> Accordingly, in responding to the above rejections, Applicants herein expressly decline to provide any characterization of McAlpine on the merits vis-à-vis the claimed invention. Applicants also do not acquiesce as to the validity and/or correctness of the Examiner's characterizations of the claims and/or other documents relied upon by the Examiner. Applicants expressly reserve the right to challenge during prosecution and/or in any other forum (e.g., litigation and/or re-examination) the validity and/or correctness of the Examiner's characterizations of the claims, as well as, the documents cited against the subject application.

Claim 58 stands rejected as obvious over Williams (6,957,269) in view of Lee (6,859,435). The Examiner suggests combining the priority levels described in Lee with Williams' teaching of a frame having a parameter indicating a pause time. However, MPEP 2145 X.D.2 states:

**2. References Cannot Be Combined Where Reference Teaches Away from Their Combination**

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

In this case, much like *In re Graselli*, Lee expressly excludes including a time value in a control frame. Lee states:

rather than coding the PAUSE frame's parameter to represent the period of time that the upstream neighbor should not send data frames, the parameter is coded to represent the various Transmit Feedback values [col. 14, lines 7-11]

Therefore, it is improper to combine Lee with Williams in the proposed manner.

Thus, Attorney for Applicant respectfully requests withdrawal of the rejections of claim 58. For at least the same reasons Attorney for Applicant requests withdrawal of the rejections of dependent claims 60 and 61. For similar reasons, Attorney for Applicant requests withdrawal of the rejections of independent claims 62, 64, and 67 and their corresponding dependent claims.

If any fees are due, please apply such fees to Deposit Account No. 50-0221.

Respectfully submitted,

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